

view of U.S. Patent 6,085,112 ("*Kleinschmidt*"). The cover sheet to the Office Action indicates claims 20–26 are rejected; however, no specific detailed grounds of rejection were given with respect to claim 20 anywhere in the Office Action. As claims 21–23 and 26 incorporate all elements of claim 20, it appears the only rejection by the Examiner against claim 20 was under § 102(b) as anticipated by *Miyake*. So that the written record in this case will be complete, the Examiner is requested to confirm whether the basis for rejection of claim 20 was under § 102(b) as being anticipated by *Miyake*.

Amendment

By this amendment, Applicant has amended claim 20 as to correct typographical errors, which identifies the antecedent basis for the claim term "removable memory unit" and inserts the word "section." Amendments are noted in the attached Appendix with deletions noted by square brackets and insertions noted by underlining. No change has been made affecting the scope of the claims. No new matter has been added.

Rejection of claim 20

To anticipate a claim under 35 U.S.C. § 102(b), a reference must disclose each element recited in a claim. (MPEP § 2131 (8th ed. 2001).) Because *Miyake* fails to disclose each element of claim 20, Applicant respectfully traverses this rejection, at least for the reasons set forth below.

The Examiner correctly acknowledges that "Applicant's invention is not the same as the prior art invention," but goes on to allege, "Applicant's claims are written broadly enough where the prior art can be read on it." (Paper No. 6, at 3, 4, and 6.) Because

the Examiner has failed to cite references that disclose each claim element, as set forth below, Applicant disagrees.

Claim 20 recites, *inter alia*:

A portable camera being carried by an operator, comprising:
... a terminal to transmit image data to an external device or to receive image data from an external device; wherein the portable camera is adapted to receive second image data having a second data format different from the first data format with the removable memory unit capable of being accommodated in the memory section or through the terminal from an external device and the processing section processes the second image data so that the display section displays an image of the second image data.

Miyake discloses an image data transfer system operable with an electronic still camera. The camera 10 includes an imaging device 108, which may be a CCD image sensor. (*Miyake*, col. 3, ll. 39–43.) Analog signals are fed from the imaging device 108 to a signal processor 110, which are then applied to an ADC 112. (*Id.*, at col. 3, lines 48–49 and 56–58.) The ADC 112 converts the signal to data having eight to ten bits, which are fed to a Y/C processor 114 in parallel. (*Id.*, at col. 3, lines 61–62.) An internal compander 122 selectively compresses or expands (i.e., decompresses, that is returned to its original state) the YC image data. (*Id.*, at col. 4, lines 44–46.) When data is sent out to equipment 20 (including display 206) or read out from a memory card 120, the data is either non-compressed or decompressed by compander 122 (*Id.*, at col. 4, lines 39–43 and 56–61.) That is, uncompressed data, originally detected by an imaging device, may be sent to a display, and data may be internally compressed.

Uncompressed data, originally detected by an imaging device, may be sent to a display, however is not the same as “wherein the portable camera is adapted to receive”

second image data having a second data format different from the first data format," as recited in claim 20. The Examiner asserts that Miyake discloses:

wherein the portable camera is adapted to receive second image data (second image data is compressed image data read from the removable memory) having a second format (compressed data inherently has a format different from non-compressed data) different from the first data format with a removable memory unit capable of being accommodated in the memory section and the processing section processes the second image data (the processor decompresses the image data from the memory card for subsequent display) so that the display section displays an image of the second image data (see col. 4, lines 44-61).

(Paper No. 8 at 4.) However this does not disclose that the portable camera is adapted to receive second image data having a second data format. Under the Examiner's construction, the portable camera internally generates compressed data.

Further, *Miyake* cannot be said to disclose at least a portable camera adapted to receive second image data having a second data format as claimed . Even assuming for the sake of argument (which Applicant disputes) that compressed and non-compressed data differ in format, *Miyake* internally generates the non-compressed data and, thus, the camera 10 is not adapted to receive second image data having a second data format. Accordingly, *Miyake* cannot be said to anticipate claim 20, as it fails to disclose each and every element recited. Withdrawal of the rejection of claim 20 is therefore requested.

Rejection of claims 21-23 and 26

At least because of their dependence from allowable claim 20, claims 21-23 and 26 should likewise be allowed.

Rejection of claims 24–25

As noted above, *Miyake* fails to disclose, at least, “wherein the portable camera is adapted to receive second image data having a second data format different from the first data format,” as recited in claim 20, which is incorporated into claims 24–25.

Kleinschmidt does not compensate for this deficiency.

Accordingly the rejection of claims 24 and 25 is respectfully traversed, since a *prima facie* case of obviousness has not been made by the Examiner.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.3 (8th ed. 2001).) Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure. (M.P.E.P. § 2143 (8th ed. 2001)).

Therefore, because *Miyake* fails to disclose or suggest each claim element and *Kleinschmidt* fails to compensate for these deficiencies, claims 24–25 should likewise be allowed.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 20–26 in condition for allowance. Applicant submits that the proposed amendments of claim 20 are made to improve form, and do

not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Applicant also notes that the Office Action dated August 14, 2002, was made final, although the Examiner cited new references against the pending claims, and identified no basis justifying the finality. In addition, as pointed out above, no detailed grounds of rejection were given with respect to claim 20. Therefore, Applicant respectfully requests the withdrawal of the finality of the last Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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APPENDIX

20. A portable camera being carried by an operator, comprising:

a photographing element for converting photoelectrically an image of an object into electrical image signals;

a processing section to process the electrical image signals so as to output first image data having a first data format;

a memory section to accommodate a removable memory unit in which the processing section stores the first image data;

a display section to display an image, wherein the processing section processes the first image data so that the display section displays an image of the first image data;

a terminal to transmit image data to an external device or to receive image data from an external device;

wherein the portable camera is adapted to receive second image data having a second data format different from the first data format with a removable memory unit capable of being accommodated in the memory section or through the terminal from an external device and the processing section processes the second image data so that the display section displays an image of the second image data.